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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,907	11/06/1998	VICTOR GIRARDI	E-775	3608

7590 05/17/2002

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HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/17/2002

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/187,907
Filing Date: November 06, 1998
Appellant(s): GIRARDI ET AL.

Steven J. Shapiro Reg. No. 35,677
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 06 March 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existance of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3 and 7-8, claims 4 and 13, claims 5 and 12, claim 6, and claims 9-11 and 14-15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,801,944	KARA	9-1998
5,873,073	BRESNAN et al.	2-1999
5,174,493	FILE	12-1992

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara, U.S. 5,801,944 in view of Bresnan et al., U.S. Patent No. 5,873,073 and File, U.S. Patent No. 5,174,493.

As per claims 1-15, Kara teaches a method and processor based system for printing indicia onto a document (abstract, lines 1-14; figures 16A, B and 18; column 6, 10-34). Kara also teaches document folding (column/line 5/65-6/4). However, Kara does not teach of fold configuration selection. File teaches C and Z fold reply envelopes (figures 1-9). File also teaches first and second evidences of postage (figures 1, 2, 4, 7 and 9; column 4, lines 34-44; column 5, lines 42-58). Although, File does not disclose half-folds, the Examiner takes Official Notice that document fold configurations are well known in the art of document and mail

processing. And, that these folds can be applied according to the message that a user would like to convey to the document or mailer recipient. Bresnan et al. teach a mail piece production system. In particular, Bresnan et al. discloses a method and system for producing a finished mail piece that:

- allows users to select first and second fold configurations (column 8, lines 40-62; column/line 9/63-10/8)
- allows users to select amongst half, C or Z folds (column 8, lines 56-62; column 10, lines 5-7)
- identifies to the processor the configuration selections and creating the document the document (column 2, lines 21-50; column 3, lines 15-56; column 8, lines 4062; column/line 9/63-10/8)
- allows a user to input secondary information such as paper size (column 8, lines 60-62)
- document printing, metering, return envelopes and inserts (abstract, lines 4-17; column/line 9/63-10/26; column 11, lines 20-38; column/line 18/61-19/12)
- allows users to select simplex or duplex printing (column 2, lines 24-27; column 8, lines 40-50)

Therefore, it would have been obvious to combine the teachings of Kara, File and Bresnan et al. Mailers that include reply documents as part of a document or as inserts are well known. Some of these reply mailings have postage already

accounted for by the mailer source (e.g. "No postage necessary..."). Using the system of Kara a user can print a first postage indicia on the original document and a second indicia on the reply document. File teaches that a "reply" can have a plurality of fold configurations ('493, column 1, lines 40-43). By applying the configuration selection of Bresnan et al., a user can accommodate multiple configurations and print indicia according to fold (e.g. c, z and half) and print specifications (e.g. simplex or duplex) ('944, figures 16A and B; '073, abstract, lines 8-13; column 2, lines 21-43).

(11) Response to Argument

In general, appellant's arguments reflect a difference of opinion over the teachings of the prior art and how these teachings would be evaluated in light of the knowledge generally available to those in the appropriate art and the level of ordinary skill in this art.

In addition, the Appellant's failure to challenge the Examiner's Official Notices has resulted in the following to be acknowledged as admitted prior art:

- document fold configurations such as half folds are well known in the art of document and mail processing (Paper No.6, page 3, lines 14-16)

Initially, the appellant's argument is based on a piecemeal reading of the prior art. The appellant in their reply stress certain features of the claimed invention that are not found, in the teachings of Kara, Bresnan et al. and File when taken individually. However, the test for obviousness under U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest (*In re Conrad*, 169 USPQ 170 (CCPA 1971)).

The crux of the appellant's argument is that neither Kara, Bresnan et al. nor File teach a postage metering system for creating a document having first and second evidences of postage and determining first and second evidences of postage based on user-selected fold configurations (Reply Brief, page 6, lines 3-8). The Examiner respectfully disagrees. Kara teaches a system that applies indicia to mail pieces comprising envelopes and/or documents and return envelope folding ('944, abstract; figures 16A-B and 18; column/line 5/65-6/5), while File teaches a mailer of varying fold configurations with an indicia baring reply envelope ('493, abstract), and Bresnan et al. teach user selected fold types for mailer inserts ('073, column 10, lines 1-7). Therefore, it would have been obvious to one of ordinary skill to use the fold selection feature of Bresnan et al. to fold a document (compare appellant's figures 17-19 and File, figures 6-9). Regarding first and second fold configurations, the appellant's specification details a system where a document is folded using one fold configuration

(Specification, page 12, lines 5-27 and figures 2 and 4) and if a return mailpiece is desired a second or alternative configuration is selected (Specification page 17, lines 1-13 and figure 19). Hence, to one of ordinary skill it would have been obvious to provide users with such a choice as return envelopes are not always required ('073, column 2, lines 20-30). In addition, to one of ordinary skill it is apparent that File and Bresnan et al. teach first and second evidences of postage in first and second designated locations of a document. File discloses a mailer that contains a return envelope with indicia ('493, figures 6-9; column/line 1/40-2/16; column 4, lines 34-45; column 5, lines 42-58) (see also appellant's figures 17-19) and Bresnan et al. teach return envelopes (column 2, lines 21-30). Return envelopes are contained within initial mailers that require evidences of postage in order to be mailed. Hence, a second evidence of postage indicia is present at least when "no postage necessary" is to be placed on the return envelope. Similarly, in order for a Post Office to verify the postage paid (i.e. evidence of postage) it is required that evidences of postage be placed in the right hand corner of an envelope. Therefore, in order to meet these specifications evidences of postage are placed on a mail piece dependent on the fold configurations (e.g. half, c or z) in order for these marks to be properly collated by postal authorities and/or equipment.

Finally, the appellant is of the opinion that there is lack of motivation to combine the references of Kara, Bresnan et al. and File. Again, the Examiner

respectfully disagrees. Recall Kara teach a general system for folding and applying indicia to envelopes and/or documents ('944, figures 18-20; column/line 5/65-6/10), File provides users with mailers that contain multiple fold configuration return envelopes with indicia ('493, abstract; column 1, lines 40-57) and Bresnan et al. teach fold selection ('073, column 10, lines 1-8) therefore it would have been obvious to one of ordinary skill to combine the systems of Kara, Bresnan et al., and File in order to meet the needs of businesses that desire mailers containing return envelopes with indicia ('493, abstract; column 1, lines 40-57). (A reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art (*In re Delisle*, 160USPQ 806 (CCPA 1969)).

(12) Conclusion

Appellant's arguments are not persuasive in that they fail to consider the full teachings of the combined references and more importantly what they would suggest to those of ordinary skill in the appropriate art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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May 13, 2002

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